

REMARKS/ARGUMENTS

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

Claims 1-6, 8-11, 12-24, 26-29, 31-41, 43 and 44 are pending in the present application. No claims are amended by the present amendment, thus, no new matter is added.

In the outstanding Office Action, Claims 1-6, 8, 9, 12-24, 26, 27, 30, 31, 34-39, 42 and 43 were rejected under 35 U.S.C. §103(a) as unpatentable over Van Hees alone or in view of Kajander et al. (U.S. Pat. No. 6,723,670, herein "Kajander"); Claims 10, 11, 28, 29, 40 and 41 were rejected under 35 U.S.C. §103(a) as unpatentable over Van Hees, Kajander in further view of Finley (U.S. Pat. No. 5,578,363); and Claims 32 and 33 were rejected under 35 U.S.C. §103(a) as unpatentable over Van Hees.

Addressing now the rejection of Claims 1-6, 8, 9, 12-14, 16-24, 26, 27, and 30-43 under §103(a) as unpatentable over Van Hees alone or in view of Kajander, this rejection is respectfully traversed.

Claim 1 recites,

an assembly comprising:

a wood floor directly above and in contact with a material consisting of a felt of mineral fibers, the material consisting of a felt of mineral fibers configured to specifically attenuate a noise of an impact with the wood floor emitted in a same room as the wood floor,

wherein the felt includes binder that is in an amount from 3 to 30% by weight and the felt is created using an internal centrifugation process.

Claims 20, 32, 34 and 44 recite similar features with regard to the felt and the material.

Van Hees describes a glass fiber mat used for sound insulation of a floating slab.

Further Van Hees describes that the floating slab or screed is made of cement.¹ Additionally,

¹ Van Hees, page 1, line 23.

Van Hees describes that a waterproof material is inserted between the insulating material and the floating slab in order to protect the material from the moisture of the cement.²

However, Van Hees does not describe or suggest a felt that is created using an internal centrifugation process, as is recited in Claim 1.

The outstanding Action states on page 5 that "the limitation "the felt is created using an internal centrifugation process" is considered a product-by-process limitation in an apparatus claim....See MPEP 2113." With respect to this assertion Applicants respectfully submit that even if the features of Claim 1 are considered to be product-by-process, these features patentably distinguish over the description of Van Hees and Kajander considered individually or in combination.

Specifically, the first paragraph of MPEP §2113 states,

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

However there is an exception to this rule as is indicated in the second paragraph of MPEP §2113, which states,

The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. See, e.g., *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979) (holding "interbonded by interfusion" to limit structure of the claimed composite and noting that terms such as "welded," "intermixed," "ground in place," "press fitted," and "etched"

² Van Hees, page 3, lines 4-16.

are capable of construction as structural limitations.) (emphasis added).

In the present case, the internal centrifugation process does impart distinctive structural characteristics to the felt which allow the felt to be configured to specifically attenuate a noise of an impact with the wood floor emitted in a same room as the wood floor. This configuration is possible as a result of the use of this type of felt, a type of felt not described or suggested in any of the cited references.

For instance, Van Hees simply describes that a “glass fibre mat” is used with no description or suggestion that this “glass fibre mat” is created using an internal centrifugation process. Moreover, Applicants respectfully submit that the “glass fibre mat” of Van Hees is not produced by an internal centrifugation process.

The outstanding Action asserts on page 2 that “Applicant’s argument that the felt of VanHees is not produced [by] the claimed process is not persuasive as applicants merely present conjecture not supported by any factual evidence [that] the mat is not or could not be made by the claimed process.” In response, Applicants note that the evidence that the “glass fibre mat” of Van Hees is not created by the claimed internal centrifugation process is that Van Hees never asserts that the “glass fibre mat” made by an internal centrifugation process and thus it cannot be assumed that this reference describes such a process.

[Nevertheless, Applicants have provided additional evidence that the “glass fibre mat” of Van Hees is not created by an internal centrifugation process. Specifically, Applicants have filed herewith a declaration by the inventor of Van Hees which states this exact point.]

In addition, Kajander, from the description found therein of how the glass fibre mat is created, clearly does not describe a felt created using an internal centrifugation process.

Moreover, with regard to the assertion on page 2 of the outstanding Office Action that “the claims do not provide any distinguishing structural features to support applicant’s conjecture,” Applicants respectfully traverse this assertion as erroneous. Specifically, as was

noted above, “where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product,” “the structure *implied* by the process steps should be considered.” In the present case, distinguishing structure is clearly implied by the fact that the felt is created using an internal centrifugation process, which clearly distinguishes the claims from the cited references.

In addition, Applicants respectfully submit that it would not have been obvious to substitute a wood floor for the concrete floor described in Van Hees or to remove the waterproof layer from the material which is directly below and in contact with the concrete floor in Van Hees.

The outstanding Action states on page 4 that “it is noted that it has been held that one of ordinary skill in the art would be motivated to pursue and or substitute known options within his/her technical grasp and if the substitution or variation yields predictable results (sound attenuation in the instant case) it is likely not the product of innovation but of obviousness.”

MPEP §2141 states

The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396.

Further, as is noted in MPEP §2143.01 “The mere fact that references can be combined or modified does not render the resultant combination obvious unless **>the results would have been predictable to one of ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007).”

In other words, there must be some rationale for why one skilled in the art would use a fibre mat such as that described in Van Hees which is specifically designed for use with a concrete floor with a wood floor. The outstanding Action asserts that using the mat of Van Hees with a wood floor would yield predictable results (i.e. sound attenuation) and the waterproof layer would not have been needed if the floor was a wood floor. However, one skilled in the art would know that the frequencies of sound created by contacting the same object under the same conditions against a wood floor and against a concrete floor are different. As a result, material designed to address the specific frequencies produced by contact with a wood floor would be different from a material designed to address the specific frequencies produced by contact with a concrete floor.

For example, [as is evidenced by the attached declaration] a concrete floor and a wood floor have very different weight and, as a consequence, do not produce the same frequencies when contacted. The critical frequency in the case of concrete is about 120Hz while the critical frequency of a wood floor is above 300Hz. Note that the critical frequency is the resonance frequency of the system.

Thus one skilled in the art would not have any rationale for using a mat such is described in Van Hees with a wood floor, as the mat of Van Hees is not designed to be used with a wood floor.

Therefore Applicants respectfully submit that the mat of Van Hees is not structurally or functionally equivalent to the material recited in Claim 1.

In addition, Kajander does not cure the above noted deficiencies of Van Hees with regard to the claimed invention.

Accordingly, in light of the above discussion, Applicants respectfully submit that Claims 1, 32, 34 and 44 and claims depending therefrom patentably distinguish over Van Hees and Kajander considered alone or in any proper combination.

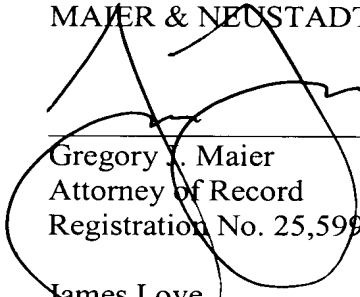
Consequently, in light of the above discussion and in view of the present amendment, the application is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/07)



Gregory J. Maier
Attorney of Record
Registration No. 25,599

James Love
Registration No. 58,421